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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,947	05/04/2005	Philippe Combette	271115US0PCT	9640
22850 7590 09/18/2007 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER LILLING, HERBERT J	
			ART UNIT 1657	PAPER NUMBER
			NOTIFICATION DATE 09/18/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Office Action Summary**

Application No.

10/533,947

Applicant(s)

COMBETTE ET AL.

Examiner

HERBERT J. LILLING

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05-4-2005 & 06-27-2005 -Preliminary Amds.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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1. Receipt is acknowledged of a prior art information disclosure statement filed June 27, 2005 and two preliminary amendments filed May 04, 2005 and June 27, 2005 for this application which is a 371 of PCT/FR03/50117 filed November 12, 2003 which claims benefit to FRANCE 02/14177 filed November 13, 2002.

2. Claims 1-25 are pending in this application.

3. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, drawn to a micro-system for receiving beads and obtaining a precise positioning of said beads at preset locations in said micro-system, comprising: a tank that has a cavity, which is fitted with blocking elements having the form of columns, said blocking elements allowing to block beads to be tacked in interstices between said blocking elements in an ordered way and in stacks, said interstices constituting said preset locations, a cap hermetically sealing said tank, and import means and output means allowing a fluid to flow in said cavity, classified in Class 435, subclass 287.1+ depending upon the additional factors within the micro-system.

Claims 2-21 will be examined with this Group which includes additional limitations for the micro-system and process of making the micro-system.

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Group II, claims 22-25, drawn to a process for implementing a biochemical or biological reaction, comprising flowing a fluid stream in the micro-reactor according to claim 11, so that at least one constituent of said fluid stream reacts with pre-functionalised beads able to produce a chemical, electrochemical, biological or biochemical reaction, and at micro-reactor output(s) a fluid stream is collected that includes product(s) of said reaction, classified in Class 435, subclass 4+.

4. The inventions are independent or distinct, each from the other because

this request for restriction between the Inventions above meet the two requirements

a. Each invention as claimed requires a mutually exclusive characteristic not required for the other invention and the inventions as claimed are not obvious variants.

and

b. There would be a serious burden on this Examiner if restriction were not required. This serious burden is that the search and examination for one of the claimed inventions is not required for another of the claimed inventions. The grounds for this "serious burden" is the prima facie evidence that one or more of the following has been met:

i.> separate classification;

ii.> separate status in the art;

iii.> different field of search in accordance with MPEP 808.02 whereby it is considered that the search for one of the inventions which would not likely to result in finding art pertinent to the other invention due to computerized electronic sources which requires different search queries;

iv> if the prior art applicable to one invention would likely not be applicable to another invention;

and

v.> the inventions are likely to raise different non-prior art issues under 35 USC 101 and/or 35 USC 112 Para. 1

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Additional evidence that the restriction is proper for the above inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1 is clearly on the record in view of the various anticipatory art submitted in the PCT based on US 5,942,443 or equivalence and/ or US (6602702 or 6589779 or 6749814 or 6737026 or 6150180).

5. Applicant is advised that the reply to this requirement to be complete must include (i) an election of an invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. In accordance with this Tech Center Policy based on above restriction containing product claims and process claims, this Examiner will rejoin any non-elected process claims upon the election of a product claim which is subsequently is found allowable in view of the following guidelines:

**F.P.: Ochiai/Brouwer Rejoinder form paragraph**

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. It is noted that if Applicant elects Invention I, this Examiner will transfer the application to the appropriate area. However, if Applicant elects Invention II, this Examiner will probably reject the claims under 35 USC 112 first and second paragraphs as being non-searchable for the exceptionally broad claimed language. A search and examination cannot be properly made in view of the claimed subject matter does not specify the final product(s) formed as well as the reactants which specification lacks sufficient information as to making the "pre-functionalised beads" as well as the composition of the "beads" and the reaction conditions for making the unknown products of the biochemical or biological reaction. The lack of suitable starting ingredients as well as the reaction conditions to form unknown broad components which includes "peptides or streams of proteins" does not satisfy the requirements for a complete and suitable process search for the unknown products. A search and examination requires at least a complete scope of the starting materials and the reaction conditions for the claimed product-by-process.

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There is also a possible problem with Invention II that the instant specification lacks a suitable specific utility which corresponds in scope to the subject matter sought to be patented must be taken as sufficient to satisfy the utility requirement of paragraph 101 for the entire claimed subject matter.

9. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lilling whose telephone number is 571-272-0918 and Fax Number is **571-273-8300**, or SPE Jon Weber whose telephone number is 571-272-0925. Examiner can be reached Monday-Friday from about 7:30 A.M. to about 7:00 P.M. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Art Unit 1657  
August 29, 2007



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